REMARKS/ARGUMENTS

Upon entry of this amendment, claims 110-127 will be pending in this application. Claims 126 and 127 are newly added. Support for claims 126-127 are found in original claim 117. No new matter has been introduced. Reconsideration is respectfully requested.

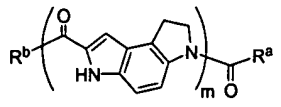
I. Objection

Claim 117 was objected to as being improperly dependent on a multiple dependent claim. In response, Applicants have amended claim 117. In view of the amendment, Applicants believe that the objection is overcome. Applicants respectfully request that the objection on claim 117 be withdrawn.

II. Restriction Requirement

In response to the restriction requirement for claims 118, 121 and 124 in the Office Action mailed on June 1, 2006,

for claim 118, Applicants elect with traverse, to prosecute the modified base $(NH_2)_2$BuPPAOH ;

for claim 121, Applicants elect with traverse, to prosecute the minor groove binder (MGB) having the formula: 

, where Applicants elect with traverse, to prosecute substituents $R^a = NR^cR^d$ and $R^b = OR^c$ and Applicants elect with traverse, to prosecute substituents R^c and R^d being $(C_1\text{-}C_{12})$heteroalkyl; and

for claim 124, Applicants elect with traverse, to prosecute hybridization conditions.

Applicants respectfully traverse the restriction requirement. First, the restriction requirement does not follow the procedure for handling generic claims. The procedure for handling applications that include generic claims is set forth in 37 C.F.R. § 1.146. The rule provides:

> In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the

> examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted **if no claim to the genus is found to be allowable.**

As stated in MPEP § 809.02(a):

> Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable claim as provided by 37 C.F.R. §1.141.

Thus, where generic claims are present, an applicant can be required to elect species for initial examination, but the generic claims are still subject to examination to determine whether such generic claims are allowable.

In the instant case, the required procedure is not followed. Claims 118, 121 and 124 are proper generic claims within the requirement set forth in 37 C.F.R. §1.141. In the restriction requirement, the Examiner alleges that there is no indication given that the listed nucleotide modifications are functionally equivalent for claim 118; there is no evidence to suggest that the various possible minor grove binders encompassed by the claim have a consistent effect on the oligonucleotide structural integrity for claim 121; and the different methods detailed within claim 124 make use of different materials and reagents and require taking into account very different parameters. However, claims 118, 121 and 124 satisfy the definition of a generic claim as set forth in MPEP § 806.04(d), in that these generic claims do not include limitations that are not present in all claims that depend from it. Therefore, claims 118, 121 and 124 are, in fact proper generic claims. As such, in the present case, an election of species requirement is permissible, but a restriction requirement is not.

Second, as set forth in MPEP §808.01(a) and §803.02 :

> In application where only generic claims are presented, restriction cannot be required unless the generic claims recite **such a multiplicity of species that an unduly extensive and burdensome search would be necessary to search the entire scope of the claim.** §808.01(a)
>
> If the members of the Markush group are **sufficiently few in number** or so closely related that a search and examination of the entire claim can be made without serious

> burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they may be directed to independent and distinct inventions. §803.02

Generic claim 118 is drawn to **14 specific** compounds whose structures are shown in Figs. 1A and 1B. Compounds PPA, PPPA, $(NH_2)_2$PPPA, $(NH_2)_2$PPPAOH, $(NH_2)_2$BuPPAOH and $(NH_2)_2$PPAI have a common pyrazolo[3,4-d]adenine substructure with a substituted propynyl group at the 3-position of the base structure and optionally a NH_2 group at the 7-position. The substituents for the propynyl group are H, OH, NH_2 and CH_2OH. Compounds PPG, PPPG and HOBuPPG have a common pyrazolo[3,4-d]guanine analog substructure with a propynyl or a hydroxybutynyl group at the 3-position. Compounds PU, HOPU and HOBuU have an uracil substructure with a propynyl, a hydroxypropynyl or a hydroxybutynyl group at the 3-position. Compounds PC and HOBuC have a cytosine substructure with a propynyl or a hydoxylbutynyl group at the 3-position. Clearly, the members of Markush group are **sufficiently few in number**, there is no serious burden on the Examiner to exam claim 118 in its entirety.

Claim 121 is drawn to three species. All the species have a common pyrrole-based substructure, in particular, the repeat units of two species in claim 121 are regio isomers.

Claim 124 recites the method for establishing conditions for hybridization, renaturation, mapping composition or determination of sequence complexity. Although hybridization and renaturation are generally carried out in different environments from that for mapping base compositions and determination of sequence, hybridization and renaturation may provide necessary parameters for later determining the composition and sequence complexity.

Therefore, it is obvious that there is no unduly extensive and burdensome search necessary for the Examiner to examine the entire scope of all claims 121 and 124 in their entirety as defined in MPEP §808.01(a).

Third, because the restriction requirement splits a single claim into multiple groups, for example, claim 118 into fourteen groups; claim 121 into three groups; and claim 124 into four groups, the restriction requirement is improper as a matter of law. **The courts have long held that the section of the patent statute that authorizes restriction practice, i.e., 35**

U.S.C. §121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. see, *In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (CCPA 1978). As stated in *In re Weber*:

> The discretionary power to limit one applicant to one invention is **no excuse at all for refusing to examine a broad generic claim** -- no matter how broad, which means no matter how many independently patentable inventions may fall within it. 198 USPQ 328 at 334.

As such, the Examiner's statements that "the species are independent or distinct because they represent highly divergent nucleotide modifications" and "the species and subspecies are independent or distinct because they represent different attached minor groove binding molecules" are not proper grounds for issuing a restriction requirement (see, page 2 and page 3 of the Office Action). Again, as mentioned above, **the courts have long held that the section of the patent statute that authorizes restriction practice, i.e., 35 U.S.C §121 provides no legal authority to impose a rejection on a single claim, even if the claim present multiple independently patentable inventions.**

Moreover, in the instant case, where a claim is generic, a restriction requirement is tantamount to a rejection of the claim. The court has made this point very clear. In *In re Haas*, the court states:

> We find that the action taken by the examiner did in fact **amount to a rejection** ... Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content. In effect, there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural application could an examination of the patentability of their subject matter be obtained. 179 USPQ at 625.

If the instant restriction requirement is allowed to stand, Applicants will never be accorded **"the basic right of the applicant to claim his invention as he chooses."** *In re Weber*, 198 USPQ at 332. In *In re Webber*, the court stated that "as a general proposition, an applicant

has a right to have each claim examined on merits"(198 USPQ at 331). The court went on to state:

> If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be he equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. 198 USPQ at 331.

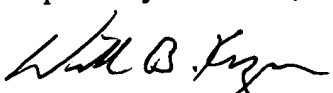
Even if the Applicants were to file fourteen divisional applications to obtain coverage for the claims in each of the fourteen species set forth in the restriction requirement, they would not have the opportunity to have their broader claim examined. The claims of the fourteen divisional applications would be limited to the particular species set forth in each of the fourteen species. In effect, the restriction requirement is reading into Applicants' claim limitations that are not present in the claim as filed. Claims 118, 121 or 124, for example, would never be considered under the current restriction requirement.

For the forgoing reasons, the restriction requirement set forth by the Examiner is improper and should be withdrawn,

Notwithstanding the foregoing, pursuant to 37 C.F.R. §1.144, Applicants reserve the right to petition for review of the restriction requirement at any time prior to appeal. Applicants also note that because the instant rejection is tantamount to a rejection of the generic claim, the restriction requirement is appealable to the Board of Patent Appeals and Interferences.

If the Examiner has any questions regarding Applicants' election, or if the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,



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